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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,939	06/23/2003	David Roy Pawloski	BCI-169US	7510
23122	7590	06/22/2005	EXAMINER	
RATNERPRESTIA			GREEN, ANTHONY J	
P O BOX 980			ART UNIT	PAPER NUMBER
VALLEY FORGE, PA 19482-0980			1755	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/601,939

Applicant(s)

PAWLOSKI, DAVID ROY

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,5,7-13,19,20,22,25,30,32 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,8,11-13,19,20,22,25,34,35 and 38-40 is/are allowed.
- 6) ☒ Claim(s) 3,5,9,10,30,32,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/14/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment submitted on 20 April 2005. Based on applicant's amendments and/or arguments the previously made art rejections are withdrawn. Currently claims 3, 5, 7-13, 19-20, 22, 25, 30, 32, 34-40 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 3, 5, 9-10, 30, 32, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama (US Patent No. 3,909,405).

The reference teaches, in column 2, lines 45+, solution of aluminum or aluminum compounds in an acidic liquid. The aluminum compounds include aluminum sulfates etc. and the acidic liquid may be any acidic liquid which can dissolve aluminum or the aluminum compounds such as mineral acids such as boric acid, various polycarboxylic acids such as oxalic, malonic, succinic acid, adipic acid, maleic acid, amino acids such as glutamic acids and mixtures of the acids.

The instant claims are obvious over the reference. While the reference does not provide a specific example wherein a composition like that instantly claimed is specifically taught, it does provide the motivation for one to produce a composition having the instantly claimed components. "A reference can be used for all it realistically

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teaches and is not limited to the disclosures in its specific examples". See In re Van Marter et al 144 USPQ 421; In re Windmer et al 147 USPQ 518, 523; and In re Chapman et al 148 USPQ 711. As for the composition being for treating the surface of a ferrous metal this is a future or an intended use and as such it adds little or no patentable weight to the claim. , The preamble limitation is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. Accordingly the instant claims are rendered obvious by the reference.

4. Claims 9-10 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diesso (US Patent No. 6,352,585).

The reference teaches, in claims 1-4, a composition comprising, gypsum, at least two acids selected from the group consisting of oxalic acid, boric acid, phosphoric acid,... aspartic acid and mixtures thereof. The composition may further contain aluminum sulfate (claim 4).

The instant claims are obvious over the reference. While the reference does not provide a specific example wherein a composition like that instantly claimed is specifically taught, it does provide the motivation for one to produce a composition having the instantly claimed components. "A reference can be used for all it realistically teaches and is not limited to the disclosures in its specific examples". See In re Van Marter et al 144 USPQ 421; In re Windmer et al 147 USPQ 518, 523; and In re Chapman et al 148 USPQ 711. As for the composition being for treating the surface of a ferrous

metal this is a future or an intended use and as such it adds little or no patentable weight to the claim. , The preamble limitation is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641. Accordingly the instant claims are rendered obvious by the reference.

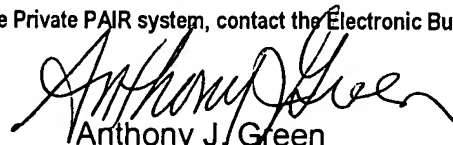
***Allowable Subject Matter***

5. Claims 7-8, 11-13, 19-20, 22, 25, 34-35, and 38-40 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, which is the most pertinent art found, fails to teach and/or fairly suggest the instantly claimed compositions and methods for treating metal surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
June 13, 2005